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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,386	03/29/2004	Kazuhisa Yokoyama	Q80760	3078
23373	7590	11/22/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			LEYSON, JOSÉPH S	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/811,386

Applicant(s)

YOKOYAMA ET AL.

Examiner

Joseph Leyson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached papers.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: Note the attached form PTO-892.

1. The request for reconsideration filed November 8, 2006 has been fully considered but it is not persuasive.

Applicants argue that the Examiner has misapplied Gardner (Gardner v. TEC Systems, Inc., 220 USPQ 777) because the width of the check ring as recited in instant claim 1 has a specific purpose and reason which is distinguishable on the facts from Gardner. The specific purpose and reason being that anything smaller than 0.3D will result in an amount of resin flow back because pressure cannot be maintained as a seal, whereas anything larger than 0.4D will result in increased breakage of long glass fibers. Applicant's original arguments in the Remarks of the Amendment filed on July 5, 2006 relative to the width of the check ring was that a width smaller than 0.3D would not function as a seal and anything larger than 0.4D would interfere with the screw. Applicant's arguments in the Remarks of the Response filed on November 8, 2006 now add that anything larger than 0.4D will result in increased breakage of long glass fibers. First, it should be noted that the instantly claimed apparatus is NOT limited to processing material with glass fibers. Again, as mentioned in the Office Action mailed on August 8, 2006, the check ring of JP '802 functions the same as applicant's check ring, i.e. the check ring seals to prevent backflow. It is inherent that the check ring of JP '802 is dimensioned to be able to seal and to not interfere with the screw, or else the check ring would not be operable. In other words, one of ordinary skill in the art after reading JP '802 would understand that the check ring therein would be dimensioned to enable the check ring to operate as intended as disclosed by JP '802.

Applicants argue that Gardner is NOT applicable because the dimensions have specific purpose and reason. The examiner respectfully disagrees. Applicants claim a check ring width range of 0.3D to 0.4D. The specific purpose and reason for the "0.3D" endpoint of the claimed dimension range is that anything smaller would not enable the check ring to seal. However, this specific purpose and reason is just finding dimensions which enable the check ring to operate as intended by both JP '802 and by Applicants, i.e. to seal and prevent backflow. Thus, the instantly claimed check ring with a width of 0.3D would NOT perform differently than the applied prior art check ring. Therefore, Gardner is clearly applicable. If the specific purpose and reason for the "0.4D" endpoint is that anything larger than 0.4D would interfere with the screw, Gardner still applies because again the dimension merely enables operability as intended with no performance difference. If the specific purpose and reason for the "0.4D" endpoint is that anything larger than 0.4D will result in increased breakage of long glass fibers, application of Gardner would be questionable, but still applicable because applicant also argues that the "0.4D" endpoint is an operability endpoint, i.e. does not interfere with the screw. However in any case, the instant claims are still properly rejected on the "0.3D" endpoint alone in view of the applied prior art because of the clear applicability of Gardner to that endpoint.

Applicants further argue that only result-effective variables can be optimized, citing MPEP 2144.05(II)(B) and In re Antonie, 195 USPQ 6, and that neither JP '802 nor Uehara (US '308) disclose that the width of a check ring is a result-effective variable. However, one of ordinary skill in the art after reading either JP '802 or Uehara (US '308)

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would understand that the dimensions of a check ring would effect its operability or inoperability for its intended purpose. In other words, it would be recognized by an artisan of ordinary skill that the apparatus dimensions effect whether or not the apparatus is operable, and that the apparatus should be dimensioned to enable it to perform as intended.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (571) 272-5061. The examiner can normally be reached on M-F 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gupta Yogendra can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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[Signature]
ROBERT DAVIS
PRIMARY EXAMINER
GROUP ~~1300~~ 1700

11/20/06